

SWEDISH – VIETNAMESE JOINT DOCTORAL PROGRAM



WELL-KNOWN TRADEMARK PROTECTION

**A COMPARATIVE STUDY BETWEEN THE LAWS
OF THE EUROPEAN UNION AND VIETNAM**

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PREFACE

In the age of globalization, trademarks have become more and more important assets not only of companies but also of countries. The contribution of well-known trademarks such as COCA-COLA, IBM, NOKIA, TOYOTA, and HONDA into the national economies is very large and quite remarkable. The traditional principles of trademark law have been challenged by the modern conditions of the world economy. Especially in the case of the well-known trademark, that protection is based not only on national law but also on the international legal framework. International attempts during the past time in order to build up a global regime of well-known trademark protection have been realized by many international conventions and treaties. Those have established legal foundations for the protection of well-known trademarks in worldwide.

From a theoretical perspective, well-known trademarks and the protection of well-known trademarks have increasingly become important topics engaging the thoughts of scholars all over the world. There have been many books and research works dealing with issues concerning well-known trademark protection in theory and legislation. However, in Vietnam, as in other developing countries legal issues concerning well-known trademark protection have still not received proper attention even though some scholars and lawyers have examined the issue to some extent in academic works and articles. That is the main reason that I decided to choose this topic for my doctoral research.

This work is not the first one in the field. However, I believe strongly that it will significantly contribute to the theoretical system of trademarks in general and well-known trademark in particular. The research has dealt with two main tasks. I begin my investigation of the regime of well-known trademark protection in a global view (through international conventions and treaties) before focusing on the situation of European Union and Vietnam. Second, based on the comparative analysis made between the two chosen legal systems, I then suggest some suitable solutions to improving the legal regime of well-known trademark protection as well as to the system of trademark law in Vietnam.

This book is the main visible result of my PhD studies of more than four years from the beginning of 2007 to the middle of 2011 at the Faculty of Law, Lund University, Sweden and Ho Chi Minh City University of Law, Vietnam. In order to obtain my results, I worked very hard throughout this time. However, the work would have been impossible without the help, encouragement and input of others.

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Ho Chi Minh City, August 2011.

PHAN NGOC TAM

UNDERTAKINGS

I declare that the book **“Well-known trademark protection – A comparative study between the laws of European Union and Vietnam”** is my own work and that all sources that I have used or quoted have been indicated and acknowledged by means of complete references.

All constructive comments and criticism on this book are welcome. I can be reached at pngoctam2001@yahoo.com.

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LIST OF ABBREVIATIONS

ACPA	Anticybersquatting Consumer Protection Act
ACTA	Anti-counterfeiting Trade Agreement
BIRPI	Bureaux Internationaux Reunis Pour La Protection De La Propiete Intellectuelle (United International Bureaus For Protection Of Intellectual Property)
EC	European Community
ECJ	European Court of Justice
EEC	European Economic Community
EU	European Union
GATS	General Agreement on Trade in Services
GATT	General Agreement on Tariffs and Trade
IP	Intellectual Property
MFN	Most Favoured Nation treatment
MOST	Ministry of Science and Technology (Vietnam)
NOIP	National Office of Intellectual Property / National Office of Industrial Property (Vietnam)
NT	National Treatment
OHIM	Office for Harmonization in the Internal Market
TLT	Trademark Law Treaty
TRIPs	Agreement on Trade-Related Aspects of Intellectual Property Rights
UC	University of California (US)
UK	The United Kingdom
US	The United States
USPTO	United States Patent and Trademark Office
WIPO	World Intellectual Property Organization
WTO	World Trade Organization

1. RESEARCHING WELL-KNOWN TRADEMARKS

BACKGROUND

Trademarks, together with patent, copyright, and other intellectual property right subject matters, has come under increasing study because they are utilized on a global scale. Actually, the concept of “trademark” has been in use from as early as the Stone Age. The predominant view regarding their historical development is that the earliest form of marking (branding) was used in respect of animals, namely, the marking of a "brand" on cattle by farmers using hot irons. This practice is portrayed in early Stone Age cave drawings, and in wall paintings of ancient Egypt. Another form of marking was the ear-cut branding of cattle, which appeared in Madagascar.¹ However, the codification of trademark law was first enacted and cases concerning the protection of trademark rights first addressed in the United Kingdom from the 1800's.² A number of international conventions have been enacted affecting trademarks as well as a great deal of national legislation relating to intellectual property rights and specifically to trademarks.³ These sources of law are necessary to protect

¹ See e.g. Amir H. Khoury, *Ancient and Islamic sources of intellectual property protection in the Middle East: A focus on trademarks*, 43 IDEA 151, 155-156 (2003). See also, World Intellectual Property Organization (WIPO), *Intellectual Property Reading Materials* 191 (WIPO Publication, Geneva 1995) ("As long as 3000 years ago, Indian craftsmen used to engrave their signatures on their artistic creations before sending them to Iran. Manufacturers from China sold goods bearing their marks in the Mediterranean area over 2,000 years ago and at one time about a thousand different Roman pottery marks were in use, including the FORTIS brand, which became so famous that it was copied and counterfeited.").

² See subchapter 2.1.2 *infra*.

³ See e.g., The Paris Convention for the Protection of Industrial Property 1883, The Madrid Agreement for The International Registration of Marks 1891, The Agreement on Trade – Related Aspects of Intellectual Property Rights (TRIPs) concluded as a part of the Uruguay Round on the re-negotiation of the GATT in 1994, The Arrangement of Nice for the International Classification of Goods and Services in 1957, First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks OJ 1989 L40/1; Council Regulation (EC) 40/94 OF 20 December 1993, OJ 1994 L11/1 on the Community Trade mark. And some national laws such as : The Trade Marks Act 1938 and after that being replaced by the Trade marks Act 1994 of the United Kingdom, The

trademarks nationally as well as globally. However, there is an important aspect of trademark law which has not been addressed in national law or in international conventions over this long period.⁴ This is the “well-known” or “famous” trademark which may be understood as a trademark which is widely known and/or used in a global context or at least within a country. In this thesis I will initially use the words well-known and famous as synonyms, but eventually I will try to make a distinction between the terms.

The lack of legislation in this field has created many difficulties for the practical use and protection of “well-known” trademarks. There have been many disputes over the years, arising in commercial transactions involving well-known trademarks. Settlements of these disputes have mainly been based upon judicial decisions in common law countries or by application of the related laws of civil law countries. This has created many obstacles to defending owners’ legitimate rights in well-known trademarks. This also has impeded the process of improving laws regarding intellectual property rights and well-known trademarks or ensuring the integrity, operation and feasibility of legal systems. Thus, establishing a legal regime with respect to well-known trademark protection that is applicable globally is one of the most important goals for the development of trademark law in national and international legal environments.

International law doctrine in respect of well-known trademarks was first incorporated into the Paris Convention of 1925. Today, an understanding of this doctrine is especially important in a world of increased global marketing and advertising. Creating a global brand has become much easier with the advent of new, less costly, and more accessible long-distance communications. While political boundaries and demarcation lines may hinder the movement of our physical bodies around the globe, they provide no barriers to the free flow of information.⁵ Thus, a trademark can be delivered everywhere at once to consumers as well as to the public in increasingly faster and more effective channels. In this manner a trademark can become widely known in many markets all over the world, unrestricted by restrictions to physical movement.

Well-known trademarks have been recognized as one of the most important types of trademark in the trademark system as reflected in both national law and in international treaties. The legal regime of well-known trademark protection has been continuously enhanced and developed over time due to the increasing importance of well-known trademarks becoming known to a worldwide public

Lanham Act 1946 of the United States of America, The Federal Trade mark Dilution Act in 1995 (as revised in 2006).

⁴ The concept of well-known trade mark was first stated in the 1925 Amendment of the Paris Convention.

⁵ Frederick Mostert, *Famous and Well-known Marks – An international Analysis*, (Toronto Butterworth’s 1997), page v.